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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,000	03/07/2000	Julie T. Dawe	10991706-1	1135

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

BRINICH, STEPHEN M

ART UNIT PAPER NUMBER

2624

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/521,000	Applicant(s) DAWE ET AL.	
	Examiner Stephen M Brinich	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12,14-22 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14-22 and 24-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 1-2, 4-12, 14-22, & 24-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaughnessy et al. or Ng et al in view of Martin et al.

Re claims 1-2, 4-6, 11-13, 14-16, 21-22, & 24-26, Shaughnessy et al (Abstract; column 5, line 66 - column 6, line 59; Figure 3a) and Ng et al (Abstract; column 5, line 10 - column 6, line 2; Figure 3) each disclose a system for selectively processing selected portions of a document image in which a predetermined color ink (highlighter pen) is applied to annotate user-selected regions of a document with alphanumeric codes. When the document is scanned, these alphanumeric codes are detected, recognized via optical character recognition, and stored (Shaughnessy et al. column 9, lines 11-33; Ng et al. column 7, lines 42-63) as annotations to be used in the following document processing. The regions associated with each are automatically determined by the processing software; these document regions are then each processed in accordance with their respective annotated instructions.

Re claims 7-10, 17-20, & 27-30, the resulting processed documents are then printed with the appearance of the annotation characters removed (e.g. the region selected by the user and

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annotated "X-5" would be shifted five units along the X axis, and printed without "X-5" appearing superimposed thereupon).

Re claims 7, 9, 17, 19, 27, & 29, a first printout used as a test print prior to the generation of a final printout is readable upon a (not further defined) recitation of a "preview image".

Shaughnessy et al or Ng et al do not disclose the selective viewing of the annotations. The selective viewing of annotations is a known element of the annotation art as disclosed by Martin et al (column 9, lines 1-9; column 12, lines 4-11). Shaughnessy et al or Ng et al and Martin et al are combinable because they are from the field of document annotation. It would have been obvious to one of ordinary skill in the art to use the selective annotation display of Martin et al in combination with Shaughnessy et al or Ng et al in order to provide the advantage of viewing the document either with the information provided in the annotations or without the clutter produced by the annotations, as desired for a given situation.

Response to Arguments

2. Applicant's arguments with respect to claims 1-2, 4-12, 14-22, & 23-30 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 703-305-4390. The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2600 Customer Service center at 703-306-0377.


If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 703-308-7452.

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Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 703-872-9306.


Stephen M Brinich
Examiner
Art Unit 2624

smb

November 29, 2004